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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,266

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EXAMINER

LAVERT, NICOLE F

ART UNIT

PAPER NUMBER

3762

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,266	Applicant(s) TANO ET AL.	
	Examiner NICOLE F. LAVERT	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 & 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regards to claims 7-9 & 12, the phrases, "to be implanted in an eye," "to be implanted in the body" and "placed in an optic nerve" are directed to non-statutory subject matter because the claims positively recites a part of the human body. It is suggested to use language such as "adapted to be implanted" or "for implanting."

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. **Claims 7 & 9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yagi (2004/0102843) in view of Byers et al. (Us 4,969,468).

In regards to **claims 7 & 9-11**, Yagi discloses, , an artificial vision system comprising (e.g., Yagi, Fig 1, 1): an image pickup device which is to be disposed outside a body of a patient and captures an image in front of the patient (Yagi, Fig 1, 4); wherein the electrodes after being stuck in the optic papilla outputs an electric stimulation signal based on a signal for stimulation pulse which is generated based on the image captured by the image pickup device to stimulate an optic nerve of the eye, thereby enabling the patient to visually recognize the image captured by the image pickup device (e.g., Yagi, [0053]-[0054])

Yagi discloses the claimed invention having an artificial vision system except for a plurality of electrodes implanted in an eye of a patient so to stick in an optic papilla, each electrode having a predetermined length. Byers et al. teaches that it is known to use electrodes employed for electrically sensing or stimulating biological tissues including electrode arrays which are disposed along the optic nerve or the paths where the optic nerve enters the cortex of an eye (e.g., column 15, ln 4-11 & Figure 1) in order to provide an excitation of the brain to induce a sensory, vision-related response. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the artificial vision system as taught by Yagi, with the electrode arrays disposed along the optic nerve as taught by Byers et al., since such modification would provide the artificial vision system with electrode arrays disposed along the optic nerve for providing the predictable results or exciting the brain to induce a sensory, vision-related response (Byers, col 15, ln 4-6). Note that the optic papilla is a location of the eye along the pathways of the optic nerve.

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In regards to **claim 12**, Yagi in view of Byers et al. discloses, the artificial vision system according to claim 10 (Yagi, Fig 1, 1) further comprising: a primary coil, a secondary coil {Yagi, [0054] & (Fig 1, 10 & 120)}, wherein the signal and power are transmitted from the external device to the internal device by electromagnetic induction occurring between the primary coil which is to be attached to a skin of the body and the secondary coil which is to be implanted in the body {Yagi, [0007], [0024] & (Fig 1, 10 & 12)}.

Response to Arguments

5. Applicant's arguments with respect to claims 7 & 9-12 have been considered but are moot in view of the new ground(s) of rejection as necessitated by amendments.

6. Applicant's arguments, filed 21 August 2008, with respect to the objections of the drawings and specification and the claim rejections under 35 U.S.C. §112 have been fully considered and are persuasive. Therefore the above objections and rejections have been withdrawn.

7. Applicant's arguments filed 21 August 2008, in regards to the claim rejections under 35 U.S.C § 101 have been fully considered but they are not persuasive. The Applicant argues that the claim phrases, "...to be implanted in an eye..." and "...to be implanted in the body..." do not recite the eye and the body as part of the system of the claims, but merely recite how the components are to be used. The Examiner disagrees and further points that the above claim phrases are directed to non-statutory subject matter because the claims positively recites a part of the human body, regardless if the claims are stating how said components are to be used. It is suggested to use language such as "adapted to be implanted" or "for implanting."

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE F. LAVERT whose telephone number is (571)270-5040. The examiner can normally be reached on M-F 7:30-5:00p.m. (Alt. Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/
Primary Examiner, Art Unit 3762

/Nicole F. LaVert/
Examiner, Art Unit 3762